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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,873	11/05/2003	Diana Amelia Normington	2003-22	6238

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PETER J.C. NORMINGTON  
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GILBERT, AZ 85234

EXAMINER
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BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/701,873	Applicant(s) NORMINGTON, DIANA AMELIA	
	Examiner Carolyn T. Blake	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,9,11-13,16,17,20,23,25-27,30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9-11,16,17,20,23,25-27 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on November 29, 2005.

#### ***Drawings***

2. The drawings are objected to because the addition of FIG 4 constitutes new matter.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The amendment filed November 29, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- In the first two paragraphs of the amendment (added following the last paragraph on page 4), these entire paragraphs constitute new matter, including the advantages and closed geometry of hand-held punches.
- Regarding the replacement for the paragraph beginning with "As illustrated in FIG 1. . .", this paragraph constitutes new matter, including the statement of what is well known in the industry and the use of a tool to push back any cut material.
- Regarding the new paragraph added after the paragraph beginning with "FIG 3 shows a separate adaptor. . .", this paragraph constitutes new matter because FIG 4 was not included in original application.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Due to the large number of amendments to the specification, Applicant is required to submit a new specification including all the changes. A statement stating no new matter was added should be included. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 2, 5, 9, 10, 11, 12, 16, 17, 20, 23, 25, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (5,749,278) in view of Snow (132,544).

Lee et al disclose a hand-held machine for piercing sheets substantially as claimed, but fail to disclose an adjustable apparatus. Snow discloses a machine for piercing sheets (see especially FIG 3) comprising an adjustable apparatus (h) that acts as a stop to a moveable cutting element (D) thereby varying an amount of material cut; and the adjustable apparatus (h) is an externally threaded piece of hardware located in a matching threaded insert attached to the frame such that said externally threaded piece of hardware can be rotated within said threaded insert moving said threaded piece of hardware up and down thereby adjusting and controlling the amount of travel of the cutting element. The adjustable apparatus varies the amount the work piece is cut. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adjustable apparatus, as disclosed by Snow, on the Lee et al device for the purpose of varying the amount the work piece is cut.

***Response to Arguments***

8. Applicant's arguments filed November 29, 2005 have been fully considered but they are not persuasive.

9. Applicant argues the Lee et al and Snow references cannot be combined to anticipate the claimed invention. The examiner disagrees. Lee et al disclose a punch. As with all hand-operated punches, the Lee et al punch length can be varied manually, in this case by applying different forces to the lever. These different forces would create both complete punches and partial punches. While the Snow reference could also be varied manually, the use of a stop member (h) is employed to vary the amount the work piece is cut. It would have been obvious to use the Snow teaching of a stop reference on the Lee punch to eliminate the need for manual control.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-

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4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CB

February 3, 2006



Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700